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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,392	11/06/2001	David K. Locke	47079-0119	7604

7590 06/25/2004

Michael J. Blankstein
WMS Gaming Inc.
800 South Northpoint Boulevard
Waukegan, IL 60085

EXAMINER	
MARKS, CHRISTINA M	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/992,392	LOCKE ET AL.	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04052004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US Patent No. 5,980,384).

Barrie discloses a slot machine that has rotatable reels (FIG 1, references 119a-119c) bearing a plurality of discrete symbols (FIG 1, references 120a-120i) and a continuous graphical element (FIG 1, references 126a-126l) extending between adjacent symbols on the reel (FIG 1) such that the discrete symbols become unified by the graphical element (Column 2, lines 1-5 and FIG 1). The reels are operable to rotate wherein the continuous graphical element does not rotate giving it a velocity different from the discrete symbols which are rotating (Column 4). The reel is then stopped to place the discrete symbols in visual association of the display (FIG 1). Barrie does not disclose that the continuous graphical element extends between adjacent symbols on the same row; however, it would have been obvious to one of ordinary skill in the art to allow the continuous element to run vertically, thus existing separately on each row. The

functionality would still remain the same, as there is the same number of elements vertically as there are horizontally and the change would have no affect on the game as disclosed. The usage of one over another would be a design choice based on the preferences for presentation to the skilled artisan. Motivation for using a vertical element over the disclosed horizontal one would be to not have the elements crossing the reels, thus eliminating possible confusing for how the elements play in the game, or when incorporating vertical paylines as disclosed by Barrie (Column 4, lines 12-28).

Regarding claim 3, there is a payout given based upon the discrete symbols associated with the display area (Column 8, lines 43-45).

Regarding claims 4, 11, 19 and 27, the discrete symbols are not superimposed over the graphical element. In fact, Barrie discloses the graphical element is superimposed over the discrete symbols. However, such an alteration would be an aesthetic change and would not result in any structural or functionality change. Thus, superimposing the discrete symbols over the element would be a mere choice of design wherein the designer would be motivated by the wants, needs, and desires for the system. A designer would be motivated to superimpose the discrete symbols over the graphical element, for instance, in order to accentuate the base game in which a player is more likely to win (Abstract) thus providing the player with a better understanding of the base game results.

Regarding claims 5, 12, 20 and 28, the graphical element is a trail of symbols (FIG 1).

Regarding claims 6, 13, 21 and 29, the trail is also representative of a board game path as each square is part of the game (as is the normal requisite for the board game) and based upon random results is changed to lead the player to a winning game outcome. Thus, the square are representative of the path needed to win the game, are changed based on the

random outcome of another device and is comparable to other known board game paths such as monopoly, etc.

Regarding claims 7-8, 14-15, 22-23 and 30-31, the slot machine is a simulated video display; however, the usage of a mechanical reel would be obvious to a skilled artisan who would be motivated by the fact that a lot of player do not trust video slot displays as they feel they can be programmed to never let them win and thus will only play on a physical drive. This would motivate the skilled artisan to implement the game on a physical reel to attract these types of players and to achieve a more realistic feel for the game.

Regarding claims 16-17, 24 and 32-33, Barrie discloses that payouts are based on the paylines (Column 3, lines 61-62) thus the means for determining the payout is based on the movement of the discrete symbols between adjacent positions as the reel is rotated. As is known in the art the payout is based on where the symbols land, thus the payout is based on the movement between positions resulting in a winning combination and the payout accumulates based on the position the symbols end up in. The reel will be rotated which will cause the discrete symbols to move between the adjacent ones of the discrete symbol positions as the reel is rotated. The payout will hence then be determined based on the result of the movement of the discrete symbols to other adjacent symbol positions as the reel is rotated. This payout is accumulated based on the positions traversed that result in a winning combination. For example, if the symbol traverses to a winning line it will have accumulated a payout from zero to the winning payout based upon moving the correct number of positions to rest on the payline.

Response to Arguments

Applicant's arguments with respect to claims 1 and 3-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,517,433: Gaming system with spinning reels that has a superimposed second reel that rotates independently of the base reel.

US Patent No. 6,565,433: Gaming machine with a continuous graphical element between two other indicia that is moves at a different velocity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
June 23, 2004

JOHN M. HOTALING, II
PRIMARY EXAMINER